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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/640,822 08/17/00 GERS-BARIAG

H BEI 637- KGB

EXAMINER
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HM12/0314

NORRIS MCLAUGHLIN & MARCUS PA  
220 EAST 42ND STREET  
NEW YORK PA 10017

ART UNIT	PAPER NUMBER
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1619  
DATE MAILED:

03/14/01

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/640,822

Applicant(s)

GERs-BARIAG ET AL.

Examiner

Lauren Q Wells

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### **DETAILED ACTION**

Claims 1-11 have been presented for examination and will be reviewed on their merits.

#### ***Priority***

It is noted that the foreign priority date is not perfected until an English translation of the priority document is provided.

#### ***Claim Objections***

Claim 8 is objected to because of the following informalities: the word "color" is spelled incorrectly. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4, and 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is rendered indefinite as a result of inconsistent terminology, as it appears that the "oil-phase" and the "fatty phase" refer to the same phase. Claim 1 is rendered further indefinite by the phrase "at most 0.5% by weight of one or more emulsifiers", as it is unclear what units the percent weight is referring to. The terms "water-in-oil type" and "desired" in claims 1 and 10 are relative terms which render the claims indefinite. The terms "water-in-oil type" and "desired" are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. A broad range or limitation

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together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 6 recites the broad recitation "chosen from . . . modified smectites, modified bentonites, modified montmorillonites and modified hectorites", and the claim also recites "in particular from the group . . . of stearalkonium hectorite and quaternium-18 hectorite" which is the narrower statement of the range/limitation. In the present instance, claim 7 recites the broad recitation "chosen from the group of amphiphilic metal oxides", and the claim also recites "in particular from the group consisting of titanium dioxide, zinc oxide . . ." which is the narrower statement of the range/limitation. In the present instance, claim 8 recites the broad recitation "in the form of a make-up and/or cosmetic stick", and the claim also recites "in particular an eyebrow pencil, kohl pencil . . ." which is the narrower statement of the range/limitation. Claims 6, 7, 8, and 9 are rejected for the use of improper Markush groups. See MPEP 2173.05(h) for examples of proper conventional or alternative Markush-type language. Claim 7 is rendered further indefinite by the phrase "further pigments", as it is unclear where the "first" pigments are claimed. Claim 10 is

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rendered indefinite by the phrase "homogenization operation". This phrase is confusing because it is not clear what the homogenization operation is and/or what it is referring to. Claim 10 is rendered further indefinite by the phrase "likewise". It is not clear whether the water phase is being compared to the oil phase, the fatty and/or wax components, or the emulsion as a whole. Finally, claim 10 is rendered broadly indefinite, as it is unclear what Applicant is claiming since Applicant admits that such a method is already known.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Msika et al. (5,939,054) in view of Nakane et al. (5,182,103).

Msika et al. teach a water-in-oil emulsion for use as a sunscreen. Msika et al. teach a composition comprising emulsifier (Dow Corning 3225 C®), decamethyl cyclopentasiloxane (oil), white petrolatum (oil), bentone 38 (stearalkonium hectorite), titanium paste (which contains titanium dioxide), alpha tocopherol acetate (antioxidant vitamin additive), and water, which

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meets claims 3, 4, 5, 6, 7, and 9. Emulsifiers are disclosed as comprising from 0.5-15% of the composition. Msika et al. teach that the emulsions of the water-in-oil type can be provided in the form of sticks. Additives disclosed include dyes. A preparation is disclosed wherein the fatty phase and emulsifier are heated, oil-soluble ingredients are added, followed by the addition, with stirring, of the water containing water-soluble ingredients, which meets claim 10. The composition is disclosed as being distributed over the human skin, which meets claim 11. The reference fails to exemplify stick forms. See Col. 1, line 6-Col. 13, line 8.

Nakane et al. teach magnesium aluminometasilicate (phyllosilicate) coated composite powders and their uses. Stick forms disclosed include lipsticks, eye-shadow sticks, and eyeliners, which meets claim 8. Compositions without emulsifiers are disclosed, which meets claim 9, see examples 38 and 39 of reference. See Col. 4, line 10-Col. 6, line 2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Msika et al. by teaching it in the stick form of Nakane et al., because of the expectation of achieving a product that is easily stored and easily applied, and because Nakane et al. teach that the composition can be in the form of a stick

The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references. Therefore, the claims are properly rejected under 35 U.S.C. § 103.

#### ***Prior Art***

The prior art made of record and not specifically relied upon in any rejections cited above is either 1) considered cumulative to the prior art that was cited in a rejection or is 2) considered pertinent to the applicant's disclosure and shows the state of the art in its field but is not

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determined by the Examiner to read upon the invention currently being prosecuted in this application.

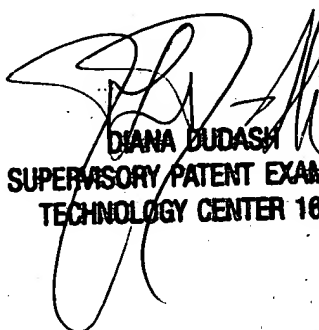
*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Lauren Q. Wells  
March 6, 2001

  
DIANA DUDASH  
SUPERVISORY PATENT EXAMINER  
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